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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,850	04/21/1999	GI YONG YOO	U012218-7	7655

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NEW YORK, NY 10023

EXAMINER

HALPERN, MARK

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 06/24/2002

115

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/295,850

Applicant(s)

YOO, GI YONG

Examiner

Mark Halpern

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s): \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1) A substitute specification less the claims is required pursuant to 37 CFR 1.125(a) because of numerous changes made to the specification and the changes were not entered by the Office. Two sets of specifications are required: a marked-up copy, and a clean copy.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

### ***Claim Objections***

2) Claims 5 and 6, are objected to because of the following informalities: the claims are dependent on cancelled claim 1. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 3) Claims 4-6, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin (KR 9007855B) in view of Webster's 3<sup>rd</sup>. New International Dictionary, Finberg (US 2,930,719), and Horimoto (US 4,620,554).

Claim 4: Shin discloses a tobacco substitute composition comprising *Eucommia ulmoides*, licorice, honey and peppermint mixture (Shin, Abstract). The percentage of *Eucommia ulmoides* in the Shin mixture calculates to about 94 weight percent, which is slightly above the upper limit of the claimed range. It would have been obvious that the percentage of *Eucommia ulmoides* reach the 90 percent level if there was a slight variation of moisture or of the other component in the Shin mixture. Licorice reads on claimed *Glycyrrhiza glabra* in view of definitions found in Webster (Webster, page 970, col. 1). The claim recites limitation of 1-10% of licorice in the composition, which is not specifically disclosed by Shin. Finberg teaches using licorice as flavourant in a casing material in a tobacco substitute at 4% (Finberg, col. 3, line 70). It would have been obvious to add the licorice to the tobacco substitute composition of Shin at 4% as taught by Finberg because such combination would accomplish the desired results of flavoring the composition. Shin also does not teach adding 1-10% of *Perilla frutescens*, also called Beefsteak according to Webster. Horimoto teaches using Beefsteak, Japanese mint, peppermint and vanilla interchangeably as flavourants in a smoking composition from 1-10% (Horimoto, col. 1, lines 53-55). It would have been obvious to combine Beefsteak and Japanese mint with the composition of Shin because the aseptic action

and tasteful properties of Beefsteak (Horimoto, col. 2, lines 10-20) and the refreshing feel and taste properties of Japanese mint, would provide further flavoring in the Shin tobacco substitute composition.

Claim 5, Shin mixture discloses glycerol. See Abstract.

Claim 6, Shin mixture discloses using peppermint (Abstract). Furthermore, Horimoto discloses using peppermint in combination with Beefsteak and Japanese mint within the claimed ranges (col. 2, list 1).

#### ***Response to Amendment***

4) Applicant's arguments filed on 8/31/2001, Paper No. 10, Supplemental Response, have been fully considered but they are not persuasive.

In reference to independent claim 4, Applicant alleges that none of the cited prior art references describe *Glycyrrhiza glabra* and *Perilla frutescens* to overcome the side effects associated with the cessation of smoking. Rather the prior art references, as well as the arguments set forth by the Examiner, describe *Glycyrrhiza glabra* and *Perilla frutescens* as flavorants. Also, the Applicant submits papers disclosing the medicinal properties of *Glycyrrhiza glabra* and *Perilla frutescens*.

The argument is not well taken. The present claim 4 is a tobacco substitute composition claim. In composition claims, if the composition is physically the same, it must have the same properties, MPEP 2112.01. The prior art cited by the examiner discloses the same composition as in present invention. The composition's purpose to

overcome effects associated with the cessation of smoking or the composition's use as flavorants is not of consideration.

- 5) Amendment received 4/17/2001, Paper No. 7, contained a marked-up copy of a Substitute Specification, said Specification was not entered by the Office. Two sets of Specifications are required as per item 1, above.

**Conclusion**

- 6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone no. is 703-308-0651.

MH

Mark Halpern  
Examiner  
Art Unit 1731

June 17, 2002

  
STEVEN P. GRIFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700